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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/249,350    02/11/99    TATTON

W    WTZ-004

000959  
LAHIVE & COCKFIELD  
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BOSTON MA 02109

HM12/0327

EXAMINER

BAHAR, M.  
ART UNIT

PAPER NUMBER

1617  
DATE MAILED:

03/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/249,350

Applicant(s)

TATTON ET AL.

Examiner

Mojdeh Bahar

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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***Detailed Action***

Applicant's response to the restriction requirement and amendment submitted February 5, 2001 (Paper No. 10) is acknowledged.

Applicant's election therein of the invention of Group I, claims 1-8 and the specie of viral infections which is HIV infection and the specie of deprenyl compounds which is (-)-desmethyldoprenyl in Paper No. 10 submitted February 5, 2001 is acknowledged.

Claims 9-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 10.

Claims 1-8 are examined on the merits herein.

The claims have been examined in so far as they relate to the elected invention and species.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatton et al. (WO 97/28791, reference D1 in the IDS filed December 13, 1999) in view of Meulen et al. (DE 19708461; English abstract provided, reference D2 in the IDS filed December 13, 1999) and Tatton et al. (Neurology, 1996, reference CB in the IDS filed June 21, 1999).

Tatton et al. (WO 97/28791) teaches a method of using deprenyl compounds in general and (-)-desmethyldoprenyl in particular to treat viral infections, (page 9, lines 15-20 and page 10, lines 25-26). Tatton et al. (WO 97/28791) also teaches a pharmaceutically acceptable carrier (page 15, lines 5-20) as well as transdermal patches as a method of administering (-)-desmethyldoprenyl (page 19, lines 17-25).

Tatton et al. (WO 97/28791) does not expressly teach the employment of a deprenyl compound generally, and (-)-desmethyldoprenyl particularly, in a method of treating HIV.

Meulen et al. (DE 19708461) teaches a method of treating viral infections of the central nervous system employing D-Methyl Seligilin (a deprenyl compound), see abstract. Meulen et al. (DE 19708461) also teaches HIV as of one of the infections in which the method would be effective, Col. 1, lines 51-55.

Tatton et al. teaches a method of using (-)-desmethyldoprenyl as a mediator of antiapoptotic action, see abstract, page 171. Tatton et al. also teaches that AIDS Protein has been shown to induce apoptosis (p174 col.2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use (-)-desmethyldoprenyl, a known antiapoptotic agent, in the treatment of HIV viral infection.

One of ordinary skill in the art would have been motivated to use (-)-desmethyldoprenyl in the treatment of HIV because (1) it is a known antiapoptotic agent and (2) is suggested to have antiviral activity. Given that AIDS protein has been known to induce apoptosis, an antiapoptotic agent would be useful in antagonizing the AIDS virus protein activity. Moreover, the Skilled

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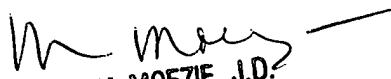
Artisan would have been motivated to employ a compound that is suggested to have antiviral activity in a method of treating the HIV viral infection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 from 8:30 a.m. to 6:30 p.m. Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar  
Patent Examiner  
March 16, 2001

  
MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600